

REMARKS

Claims 1-7, 9-26, 28-34, 36-53, 55-61, 63-80, and 82-84 are pending in the present application. Claims 8, 27, 35, 54, 62 and 81 are canceled; claims 1, 28 and 55 are amended; and claim 82 is added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The examiner has rejected claims 1-81 under 35 U.S.C. § 102(b) as being anticipated by *Paul* (U.S. Patent No. 5,999,932). This rejection is respectfully traversed.

As to claim 1, the Examiner states:

Regarding claim 1, *Paul* teaches a method in a data processing system for marking particular types of communications, said method comprising the steps of:

establishing a database of a plurality of different distinguishing identifiers, wherein each of said plurality of identifiers a particular type of communication (figure 1: 102; col. 1, lines 9-20; col. 3, lines 37-52)

receiving a communication (abstract; col. 3, lines 54-64);

determining if said communication includes one of said plurality of different identifiers (abstract; col. 2, lines 20-30); and

in response to a determination that said communication does include one of said plurality of different identifiers, marking said communication (abstract; col. 2, lines 40-47; col. 3, line 66 to col. 4, line 11).

Office Action dated March 25, 2005, page 2.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

In this case, each and every feature of the claimed invention is not found in *Paul* as believed by the Examiner. Amended claim 1, which has been amended to include subject matter previously claimed in cancelled dependent claim 8, and is representative of other rejected independent claims 28 and 55 with respect to similarly recited subject matter, reads as follows:

A method in a data processing system for marking particular types of communications, said method comprising the steps of:

establishing a database of a plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies a particular type of communication;

receiving a communication;

determining if said communication includes one of said plurality of different identifiers;

in response to a determination that said communication does include one of said plurality of different identifiers, marking said communication;

in response to a determination that said communication does not include one of said plurality of different identifiers, forwarding said communication;

determining whether said communication was deleted without being opened;

in response to a determination that said communication was deleted without being opened, determining an identifier included within said communication; and

storing said identifier as one of said plurality of identifiers in said database.

Paul is directed towards filtering email messages by comparing data contained in the "FROM" field, the "TO" field, the "SUBJECT" field, the "CC," field and "BCC" field of incoming emails stored in store with data categories stored in an inclusion list to identify emails desired by the user. The system of *Paul* teaches as follows:

According to one embodiment of the present invention, the e-mail filter 104 filters incoming mail received in the user's e-mail store 106 based upon three fields of data contained in the incoming e-mail, the "FROM" field, the "TO" field and the "SUBJECT" field. Notably, filtering may also include the "CC" field and the "BCC" field to filter e-mail messages on which the user is listed as a CC or BCC recipient rather than a direct recipient. Preferably, the e-mail filter 104 compares the "FROM", "TO", "CC", "BCC", and "SUBJECT" fields of an incoming e-mail message with the corresponding data categories stored in the inclusion list manager 102.

Paul, column 3, lines 54-65.

If the email message data matches identification data in the inclusion list, the email is marked with a display code such as "OK," and the email is forwarded to the user for display. If no match is detected, the system of *Paul* performs a heuristic process to determine whether the email may be of interest to the user. If the message is of potential interest to the user, the email is marked with a second display code, such as "NEW."

The present invention relates to a method and system for filtering electronic mail ("e-mail") sent to one or more users via a communications network to eliminate unsolicited e-mail from the user's electronic mailbox. The method and system according to the present invention sort e-mail messages by comparing one or more predetermined data fields of each e-mail messages with data stored in an automatically updated database of acceptable addresses and domains. The e-mail messages with matching data are forwarded to the respective user's mailbox. The e-mail messages without matching data are sorted using one or more heuristic sorting methods and categorized either as "junk," which are not of interest to the user, or as "new," which are of potential interest to the user. Each message is displayed to the user in accordance with its respective status.

Paul, column 1, lines 5-20.

Paul fails to teach or suggest "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers; determining whether said communication was deleted without being opened; determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened; and storing said identifier as one of said plurality of identifiers in said database," as was formerly recited in dependent claim 8 and is now recited in amended claim 1. The Examiner alleges that "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers," is taught at *Paul*, column 7, lines 26-40, which is as follows:

In the preferred embodiment of the present invention depicted in FIG. 3, the filtering process performed for each user A, B, C, and D by the e-mail filter 304 is the same as that performed by filter 104 in FIG. 1. The filter 304 compares the data stored in the "TO," "FROM," "CC," "BCC," and "SUBJECT" fields of the incoming e-mail messages with corresponding categories of data stored in the inclusion list processor 302. If data in any

of these fields of the incoming e-mail matches data stored in a corresponding field of the inclusion list processor 302, the incoming e-mail is marked "OK" and forwarded to the user. If no match is detected, the e-mail filter 304 performs at least one type of heuristic processing to determine whether the e-mail may be of interest to the user, and, if not, labels the e-mail message accordingly, for example, as "JUNK."

Paul, column 7, lines 26-40.

This cited portion of *Paul* merely teaches forwarding an e-mail message if the data stored in certain specified fields, e.g. "TO," "FROM," and "SUBJECT," match data in the inclusion list. If no match is detected, the system of *Paul* teaches performing a heuristic process to determine whether the e-mail may be of interest to the user. If it is not determined that the e-mail may be of interest to the user, *Paul* teaches labeling the e-mail message, for example, as "JUNK." The teachings of *Paul* do not teach or suggest the feature of forwarding a communication responsive to a determination that said communication does not include one of said plurality of identifiers, as recited in amended claim 1. In fact, nowhere in any section of *Paul* is forwarding a communication "responsive to a determination that said communication does not include one of said plurality of different identifiers," taught or suggested. Therefore, *Paul* fails to teach the recited feature of "forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers."

Unlike the inclusion list of *Paul*, the presently claimed invention in amended claim 1 recites "a plurality of different identifiers" which is defined in the specification as "any type of textual string, alphanumeric string, particular string of words, a particular sender, a particular number of intended recipients, a particular return address, a particular language, a particular Internet service provider source, a particular font color, a particular phrase, or any other identifier," as in the presently claimed invention. Specification, page 11, lines 12-15. *Paul* teaches as follows:

The "FROM" data stored by the inclusion list processor is created and maintained as follows. In the preferred embodiment depicted in FIG. 2, the list processor 201 initially creates the user inclusion list by automatically gathering acceptable e-mail source addresses from a plurality of sources 203 through 208. Sources 203 (user's inbox), 204 (user's outbox), and 205 (user's address book), for example, may be stored within the user's e-mail store 106 and may be accessed through user interface 108. As depicted in FIG. 2, source 206 is a database for storing a

list of e-mail addresses defined by the user. This may include, for example, the e-mail addresses displayed by the user's real time awareness and notification system. Such systems generate displays of e-mail addresses corresponding to other users who are on-line at the same time as the user. This functionality may be provided, for example, using programs such as AOL's Buddy List®, Excite's® Personal Access List®, or AOL's Instant Messenger®.

Paul, column 4, lines 41-58.

The user terminal software system of FIG. 1 further includes an e-mail storage database that receives and stores incoming e-mail and stores records of outgoing e-mail. An e-mail filter 104 filters the incoming e-mail stored in store 106 in accordance with the user inclusion list stored in database 102. A user interface 108 receives inputs from the user and displays e-mail information to the user. The user interface 108 may be implemented, for example, using a known e-mail software package, such as Netscape® Messenger®, Microsoft® Outlook®, Microsoft® Exchange®, Lotus® cc: mail®, Lotus Notes®, Novell® Groupwise®, Eudora®, or America OnLine®. User interface 108 may be used, for example, to display a user's mailbox, receive and process e-mail messages and inputs from the user, manage the user's mailbox, and display mailbox management information to enable the user to manage the mailbox.

Paul, column 3, lines 37-52.

The inclusion list of *Paul* identifies "e-mail desired by the user" (abstract). The inclusion list disclosed by *Paul* is created by an "inclusion list processor" and generated based on "acceptable e-mail source addresses from a plurality of sources" such as user's inbox, user's outbox, and user's address book. *Paul*, column 4, lines 41-49. The system of *Paul* teaches an inclusion list generated from acceptable e-mail source addresses and data in fields such as the "TO," "FROM" and "SUBJECT" fields of an e-mail. *Paul* does not teach or suggest an identifier that may be "a particular number of intended recipients," "a particular language," "a particular Internet service provider," or "any other identifier," as in the presently claimed invention.

Nowhere in this section, or any other section of *Paul*, does it teach or suggest determining if a communication was deleted without being opened, as recited in claim 1. The system of *Paul* teaches:

In addition to automatically adding new e-mail source addresses to the inclusion list, the list processor 201 may also optionally delete old

addresses from the inclusion list. For example, the list processor 201 may be programmed to delete an e-mail address from the inclusion list when the e-mail address is not stored in the user's address book, buddy list or personal manager and has not appeared in the user's inbox or outbox for a predetermined period of time, such as a month. The user may also be prompted to delete an inclusion list entry as a result of the user's deletion of an entry from the user's inbox, outbox, address book, buddy list or personal manager. The functionality of list processor 201 may be accomplished using known programming techniques as would be apparent to one of skill in the art.

The user may also manually modify the user inclusion list through the user interface 108. The list processor 201 receives any modification instruction from the user, such as "add e-mail address," "delete e-mail address," or "modify e-mail address," and modifies the stored user inclusion list accordingly.

Paul, column 5, lines 18-37.

Here, *Paul* teaches the list processor can delete old e-mail addresses from the inclusion list when the e-mail address is not in the user's address book or buddy list and has not appeared in the user's inbox or outbox for a certain period of time. *Paul* also teaches that a user may be prompted to delete an address from the inclusion list. Although *Paul* does teach deleting e-mail addresses from an inclusion list, *Paul* does not teach or suggest "determining whether said communication was deleted without being opened," as is now recited in amended claim 1.

Furthermore, *Paul* fails to teach or suggest "determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened; and storing said identifier as one of said plurality of identifiers in said database," as is now recited in amended claim 1. The Examiner alleges that this feature, which was previously recited in now cancelled dependent claim 8, is taught at column 5, lines 33-51, which is as follows:

The user may also manually modify the user inclusion list through the user interface 108. The list processor 201 receives any modification instruction from the user, such as "add e-mail address," "delete e-mail address," or "modify e-mail address," and modifies the stored user inclusion list accordingly.

The "TO," "CC," and "BCC" inclusion list categories may be initially set to automatically include the e-mail address of the user. If so, then any incoming e-mail messages having the user's e-mail address in the "TO," "CC" or "BCC" field will be displayed in the user's inbox. This

category of the user inclusion list serves to distinguish e-mail specifically directed to the user from e-mail addressed to broad categories of users. As with the "FROM" category of the inclusion list, the user may manually modify the "TO," "CC" and/or "BCC" categories to add or delete addresses as desired. This category may also be automatically updated to reflect any changes in the user's e-mail address and/or mailing lists to which the user may subscribe.

Paul, column 5, lines 33-51.

The above cited portion of *Paul* teaches modifying an inclusion list by the user manually modifying the inclusion list to add e-mail addresses or delete e-mail addresses from the inclusion list. However, *Paul* does not teach "determining an identifier" included in a communication that was "deleted without being opened," as in claim 1. The cited portion of *Paul* merely teaches initially setting up an inclusion list to include the e-mail address of the user and a user modifying the inclusion list by adding or deleting e-mail addresses. *Paul* does not teach or suggest "determining an identifier included within said communication responsive to a determination that said communication was deleted without being opened; and storing said identifier as one of said plurality of identifiers in said database," as is now recited in amended claim 1. In fact, as discussed above, *Paul* does not even teach or suggest "a plurality of identifiers" or "determining whether a communication was opened."

Paul fails to teach each and every claim limitation, therefore, *Paul* does not anticipate amended claim 1. At least by virtue of their dependency on claims 1, 28, and 55, *Paul* does not teach each and every feature of dependent claims 2-7, 9-26, 29-34, 36-53, 56-61, and 63-80. Additionally, claims 2-7, 9-26, 29-34, 36-53, 56-61, and 63-80 claim other additional combinations of features not suggested by the reference.

For example, as to claims 5, 32, and 59 the Examiner alleges that *Paul* teaches the method of claim 4, further comprising the step of compensating the service bureau at column 5, line 51. The cited portion of *Paul* teaches:

The "TO," "CC," and "BCC" inclusion list categories may be initially set to automatically include the e-mail address of the user. If so, then any incoming e-mail messages having the user's e-mail address in the "TO," "CC" or "BCC" field will be displayed in the user's inbox. This category of the user inclusion list serves to distinguish e-mail specifically directed to the user from e-mail addressed to broad categories of users. As with the "FROM" category of the inclusion list, the user may manually

modify the "TO," "CC" and/or "BCC" categories to add or delete addresses as desired. This category may also be automatically updated to reflect any changes in the user's e-mail address and/or mailing lists to which the user may subscribe.

Paul, column 5, lines 39-51.

In this section, *Paul* teaches that an inclusion list may be set to include the e-mail address of the user. In the system of *Paul*, the user may manually modify the categories to add or delete addresses. *Paul* teaches that any e-mail addresses and mailing lists that the user subscribes to may be updated in the inclusion list. Although *Paul* discusses e-mail addresses and mailing lists that the user subscribes to, *Paul* does not teach or suggest "compensating said service bureau" as recited in claim 5, 32, and 59.

As to claims 6, 33, and 60, the Examiner states that *Paul* teaches the step of establishing the database of the plurality of different distinguishing identifiers, wherein each of the plurality of identifiers identifies an unwanted communication at *Paul*, abstract. The abstract teaches the following:

A system for eliminating unsolicited electronic mail generates and stores a user inclusion list including identification data for identifying e-mail desired by the user. Data from one or more fields of incoming electronic mail messages are compared with the identification data stored in the user inclusion list. If the electronic mail message data matches corresponding identification data from the user inclusion list, the e-mail message is marked with a first display code, such as "OK." If no match is detected, the system performs at least one heuristic process to determine whether the electronic mail message may be of interest to the user. If the message satisfies one or more criteria as determined by the heuristic process and is therefore of potential interest to the user, the message is marked with a second display code, such as "NEW." If the e-mail message does not satisfy any of the heuristic criteria, the e-mail message may be marked with a third display code, such as "JUNK." The processed e-mail messages are displayed to the user in a display mode corresponding to the display codes respectively assigned to the messages.

Paul, abstract.

As shown above, *Paul* does not teach a "plurality of different distinguishing identifiers" that "identifies an unwanted communication." *Paul* teaches "a user inclusion list including identification data for identifying e-mail desired by the user." *Paul*, abstract. The inclusion list contains identification data that is used to identify desired e-

mails. The system of *Paul* only teaches marking an e-mail message as "JUNK" if "no match is detected" and if the e-mail does not satisfy "one or more criteria as determined by the heuristic process" showing that the e-mail is of interest to the user. Nowhere in any section of *Paul* is it taught or suggested that a plurality of different distinguishing identifiers identifies an unwanted communication. In contradistinction, the presently claimed invention in claims 6, 33, and 60 recites a "plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies an unwanted communication."

As to claims 9, 36, and 63, the Examiner states that *Paul* teaches the step of publishing said plurality of identifiers included within said database at figure 4. *Paul* teaches as follows:

FIG. 4 provides a process flowchart illustrating the filtering steps performed by e-mail filters 104 and 304. First, in step 401, an e-mail message is received from the network either by a user site system such as the system described in FIG. 1 or by an e-mail server such as the system described in FIG. 3. Upon receipt of an e-mail message, the e-mail filter (e.g., 104 or 304) retrieves data from selected fields of the received e-mail message as shown in step 402. In step 403, the e-mail filter compares the field data retrieved from the received message with data stored in the corresponding category of the user inclusion list. In step 410, if the field data from the received message matches a data entry stored in the corresponding category of the inclusion list, the received message is marked with a first display code indicating that the status of the message is "OK." In step 411, the field data from the received message may optionally be added to the corresponding categories of data in the user inclusion list.

Paul, column 8, lines 17-34.

As discussed above, the system of *Paul* teaches filtering e-mail messages by comparing data contained in certain fields of incoming e-mails with data categories stored in an inclusion list to identify e-mails desired by the user. The system of *Paul* also teaches updating the inclusion list by adding or deleting e-mail addresses. However, *Paul* does not teach "publishing said plurality of identifiers included within said database," as recited in claims 9, 36, and 63.

As to claims 10, 37, and 64, the Examiner believes that *Paul* teaches subscribing to a service that provides said plurality of identifiers at column 5, lines 18-32. This

section of *Paul*, quoted above, merely teaches the list processor can delete old e-mail addresses from the inclusion list when the e-mail address is not in the user's address book or buddy list and has not appeared in the user's inbox or outbox for a certain period of time. *Paul* fails to teach or suggest "the step of subscribing to a service that provides said plurality of identifiers," as is recited in claims 10, 37, and 64.

As to claims 12, 39, and 66, the Examiner alleges that *Paul* teaches the step of notifying a sender of said marked communication to discontinue communications to an intended recipient of said marked communication at column 4, lines 41-58, which is quoted above. As discussed above, this cited portion of *Paul* merely describes a list processor gathering acceptable e-mail source addresses from a plurality of sources, such as user's inbox, user's outbox, user's address book and user's buddy list. However, the cited portion of *Paul* does not teach or suggest "notifying a sender of said marked communication to discontinue communications to an intended recipient of said marked communication," as is recited in claims 12, 39 and 66.

As to claim 15, 42, and 69, the Examiner states that *Paul* teaches the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a total number of times communications have been received from a sender who transmitted said marked communication," at *Paul*, column 5, lines 5-17, which is as follows:

In a preferred embodiment, the list processor 201 also automatically updates the inclusion list. In order to ensure that the inclusion list remains current, the list processor 201 accesses (polls) e-mail address information from the sources 203 to 208 at predetermined intervals of time such as hourly, daily, weekly or monthly. The update process may also be implemented as an interrupt-driven process prompted by one or more of the sources 203 through 208. The list processor 201 compares the e-mail addresses stored in sources 203 to 208 with those stored in the user inclusion list and adds new e-mail addresses from the sources 203 to 208 to the inclusion list. In this way, the user inclusion list may be automatically updated.

Paul, column 5, lines 5-17.

Although the above cited portion of *Paul* does teach updating the inclusion list by accessing or polling e-mail address information from sources such as user's inbox, user's outbox, user's address book, user's buddy list, etc., *Paul* does not teach "identifying a

total number of times communications have been received from a sender who transmitted said marked communication," as is recited in claims 15, 42 and 69.

As to claims 17, 44, and 71, the Examiner alleges that *Paul* teaches the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a number of intended recipients at figure 2:201.

Figure 2:201 illustrates a list processor. *Paul* teaches the following:

According to one embodiment of the present invention, the inclusion list processor 201 automatically creates, stores, and updates five different categories of data corresponding to five different data fields of incoming e-mail messages: "TO," "FROM," "CC," "BCC," and "SUBJECT" and other user-definable text fields in the header.

Paul, column 4, lines 34-39.

In the preferred embodiment depicted in FIG. 2, the list processor 201 initially creates the user inclusion list by automatically gathering acceptable e-mail source addresses from a plurality of sources 203 through 208.

Paul, column 4, lines 42-46.

As described above, the list processor in figure 2:201 creates a user inclusion list from five different data fields of incoming e-mail messages by gathering acceptable e-mail source addresses from a plurality of sources. However, as discussed above, *Paul* does not teach or suggest a "plurality of different distinguishing identifiers." Nor does figure 2 teach or suggest "one of said plurality of identifiers identifying a number of intended recipients," as recited in claims 17, 44, and 71.

As to claims 20, 47, and 74, the Examiner alleges that *Paul* teaches the step of establishing said database of said plurality of different identifiers, one of said plurality of identifiers identifying a particular language, at column 9, lines 7-19, which is as follows:

E-mail messages are displayed to the user in a display format determined by their display codes (step 415). For example, "OK," "NEW" and "JUNK" messages may be displayed in different colors to indicate their different status. Other possible display modes include: a) no modification b) changing the subject line to reflect the status such as changing "Make money FAST!" to "JUNK: Make money FAST!"; c) changing font or appearance of the message subject line to reflect its status; or d) placing the message in a folder based on its status (or other modes as are known in the art). The present invention contemplates numerous display options for

the different types of e-mail messages which are apparent to those of skill in the art.

Paul, column 9, lines 7-19.

The above cited portion of *Paul* merely discloses various modes for indicating status of a message such as displaying the message in different colors or modifying the subject line, or changing font or the appearance of the subject line. However, *Paul* fails to teach or disclose "one of said plurality of identifiers identifying a particular language," as is recited in claims 20, 47, and 74.

As to claims 21, 48, and 75, the Examiner alleges that *Paul* teaches the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular Internet service provider source at column 1, lines 31-42, which is as follows:

Users of electronic mail, however, frequently are not eager to have their e-mail boxes filled with unsolicited e-mails. Users accessing the Internet through large service companies such as America Online® (AOL) or Microsoft Network® (MSN) or large businesses such as IBM® and General Motors® are targeted by e-mail marketers. The sending and receiving of unsolicited e-mail messages are increasing problems for both online services and corporations. Online services object to unsolicited mail because it reduces their users' satisfaction of their services, and corporations want to eliminate unsolicited mail because it reduces worker productivity.

Paul, column 1, lines 31-42.

The cited portion of *Paul* describes the problem of e-mail marketers targeting users accessing the Internet through large service companies, such as America Online®. However, nowhere in any section of *Paul* is identifying a particular Internet service provider source taught or suggested. *Paul* fails to teach or suggest "one of said plurality of identifiers identifying a particular Internet service provider source," as is recited in claims 21, 48, and 75.

As to claims 22, 49, and 76, the Examiner alleges that *Paul* teaches said communication comprises at least one of e-mail, instant messaging, XML messages, EDI messages, facsimiles, telephone communications, commercial messages, postal mail, packaging material, or digital images in the abstract, which is quoted above. *Paul* teaches "a user inclusion list including identification data for identifying e-mail desired

by the user." *Paul*, abstract. The inclusion list contains identification data that is used to identify desired e-mails. The system of *Paul* only teaches marking an e-mail message as "JUNK" if "no match is detected" and if the e-mail does not satisfy "one or more criteria as determined by the heuristic process" showing that the e-mail is of interest to the user. However, *Paul* fails to teach or suggest "said communication comprises at least one of e-mail, instant messaging, XML messages, EDI messages, facsimiles, telephone communications, commercial messages, postal mail, packaging material or digital images," as is recited in claims 22, 49, and 76.

Consequently, it is respectfully urged that the rejection of claims 1-7, 9-26, 29-34, 36-53, 56-61 and 63-80 have been overcome.

Consequently, it is respectfully urged that the rejection of claims 1-7, 9-26, 29-34, 36-53, 56-61 and 63-80 have been overcome. Newly added claim 82 recites subject matter addressed above with respect to claims 1-26, 29-34, 36-53, 56-62, and 63-80, and is allowable under the same rationale. Claim 82 also recites additional combinations of features not suggested by the reference. Claim 82 recites "incrementing a counter associated with a sender of a communication including an identifier stored in the database of identifiers." *Paul* does not teach or suggest "incrementing a counter associated with a sender of a communication including an identifier stored in the database of identifiers." Therefore, claim 82 is not anticipated by the cited reference.

The rejection of claims 1-80 under 35 U.S.C. § 102 has been overcome.

Furthermore, *Paul* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Paul* actually teaches away from the presently claimed invention because it teaches filtering e-mail messages by comparing data contained in the "FROM," "TO," "SUBJECT," "CC," and "BCC" field of incoming e-mails with data in an inclusion list containing, for example, acceptable e-mail source addresses, to identify e-mails desired by the user, as opposed to utilizing a plurality of distinguishing identifiers, defined as any type of textual string, alphanumeric string, particular string of words, a particular sender, a particular number of intended recipients, a particular return address, a particular language, a particular Internet service provider source, a particular font color, a particular phrase, or any other identifier; forwarding the communication in response to a determination that the communication

does not include one of the plurality of different identifiers, and determining if the communication was deleted without being opened, as in the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Paul* to mark a communication in response to a determination that the communication does include one of a plurality of different identifiers, forward a communication in response to a determination that the communication does not include one of the plurality of identifiers; and determine if the communication was deleted without being opened, one of ordinary skill in the art would not be led to modify *Paul* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Paul* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

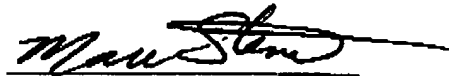
II. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 17, 2005

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